

REMARKS

In response to the Office Action mailed June 24, 2004, the present application has been carefully reviewed and amended. Entry of the present response and reconsideration of the application are respectfully requested.

Claim rejections under 35 USC §102*Claims 74, 80-81, 86 and 92-93*

Claims 74, 80-81, 86 and 92-93 stand rejected under 35 USC §102(b) as being anticipated by King (US patent 5,622,008).

The Examiner asserts King discloses an automotive weatherseal (column 3, lines 3-5) a metal reinforcement (column 4, lines 54-55) an uncured peroxide curable bonding veneer comprising the elastomeric material (column 4, lines 46-50) directly bonded to a portion of the metal, and an uncured sulfur curable, therefore non-peroxide curable, rubber layer comprising the elastomeric material on a portion of the uncured peroxide curable bonding veneer. [Paper 5, page 2].

Claim 74

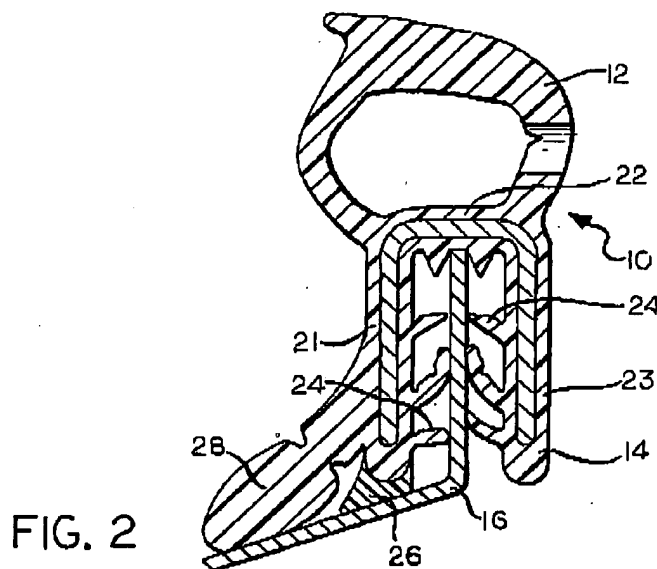
As amended, independent Claim 74 recites in part,

- (b) an uncured peroxide curable bonding veneer on at least a portion of the metal reinforcement, the uncured peroxide curable bonding veneer including a curing agent; and
- (c) an uncured sulfur curable rubber layer on at least a portion of the uncured peroxide curable bonding veneer, the uncured sulfur curable rubber layer including a curing agent.

That is, each of the bonding veneer and the rubber layer include a bonding agent, as the bonding veneer is peroxide *curable* and the rubber layer is sulfur *curable*.

As set forth in the present application, the resulting weatherseal includes a "peroxide cured rubber bonding veneer" [page 2, lines 14, 17-18]. Further, the bonding veneer is set forth as a "peroxide cured material" [Page 4, lines 2-3]. To be such material, the curing agent must be present. As set forth in the table of the feature layer [Page 5, line 23 – Page 6, line 1], and the bonding veneer, a cross linking agent is included in each material. Further, the specification refers to the "cross linked" and cross-linkable feature layer.

King discloses a single curable layer about the metal reinforcement strip, wherein the foot 26 is located on a portion of the single curable layer.



That is, a single curable (peroxide or sulfur curable) layer forms the legs 21, 23, fins 24 and bulb 12. The foot 26 is a separate material. Therefore, the only two "layers" of King are (i) the material of the legs 21, 23, fins 24 and bulb 12 and (ii) the foot 26.

In contrast to Claim 74, only one of these "layers" is curable. The foot 26 is uncured and uncurable. The uncured portion of King, the foot 26, is neither cured nor curable. Specifically,

By
omitting the curing agent from the material forming the foot
20 26 the material will never cure and achieve a stiffness
property typically achieved of a cured weatherstrip. It is (Col. 4)

Although the foot 26 of King *could* be modified to include a curing agent, King expressly and repeatedly states the foot is constructed so as to be never cured. That is, a curing agent is withheld from the foot. That the foot 26 could physically be formed with a curing agent cannot sustain the asserted rejection. 35 USC §102 requires each and every limitation be present in the reference, and is not satisfied by the standard that the reference *could* be modified. In addition, such modification is contrary to the express purpose of King – retaining an uncured foot to accommodate variations in flanges. King does not disclose the curable layer as set forth in the claim, as the King layer cannot be cured – unless a different composition is employed (a composition having a curing agent).

The recited "uncured peroxide curable rubber layer" and "uncured sulfur curable rubber layer" each include a respective curing agent so as to be curable. As King does not include a curing agent in the body and the foot 26, this limitation cannot be met.

Therefore, King does not disclose the two curable layers as recited in Claim 74. Thus, the rejection of Claim 74 cannot be sustained.

As Claims 80 and 81 depend from Claim 74, and include all the limitations thereof, these claims are also in condition for allowance.

Claim 86

Independent Claim 86 recites in part,

- (a) a metal reinforcement;
- (b) an uncured peroxide curable bonding veneer on at least a portion of the metal reinforcement, the uncured peroxide curable bonding veneer including a curing agent; and
- (c) an uncured non-peroxide cross linkable elastomer layer on at least a portion of the uncured peroxide curable bonding veneer, the uncured non-peroxide cross linkable elastomer layer including a curing agent.

As the foot 26 of King is not curable, and King only discloses a single layer of curable elastomeric material, the limitation of "non-peroxide cross linkable elastomer layer" is not disclosed in King.

Further, Claim 86 recites a "curing agent" in each of the "uncured peroxide curable bonding veneer" and the "uncured non-peroxide cross linkable elastomer layer," these features are not only absent from King, but are expressly contrary to the recited purpose of King.

Again, the rejection under 35 USC §102 cannot be sustained by a reference which "could be modified." The reference must disclose each and every limitation.

Therefore, Claim 86 is in condition for allowance.

As Claims 92 and 93 depend from Claim 86 and include all limitations thereof, these claims are also in condition for allowance.

Claim rejections under 35 USC §103

Claims 63-73, 75-79, 82-85, 87-91 and 94-97

Claims 63-73, 75-79, 82-85, 87-91 and 94-97 stand rejected under 35 USC §103 as being unpatentable over King (US patent 5,622,008) in view of Drake (US patent 5,521,248).

As the claims have been amended to more particularly distinguish King, the ability of King to serve as the primary reference has been removed. That is, King does not disclose and is expressly contrary to having a curing agent in both layers. Therefore, the asserted rejection relying upon King as the primary reference cannot be sustained.

Drake is relied upon to disclose a peroxide curable layer (column 2, lines 45-58) comprising maleinated polybutadiene (column 8, lines 66-67) and methacrylate (column 4, lines 17) and directly contacting and encapsulating a sulfur curable layer and encapsulating a metal reinforcement (the layer is flowable over the substrates, and therefore encapsulates the substrate; column 6, lines 40 - 47). [Paper 5, page 3]

The Examiner thus asserts it would have been obvious "to have provided for a peroxide curable layer of Drake et al comprising maleinated polybutadiene and methacrylate and directly contacting and encapsulating a sulfur curable layer and encapsulating a metal reinforcement ... to obtain a multilayer structure having improved adhesion as taught by Drake et al." [Paper 5, page 4]

Thus, the Examiner asserts the references render the following structure obvious:

Peroxide curable layer
<i>Sulfur curable layer</i>
Metal reinforcement

Wherein the peroxide curable layer may encapsulate the sulfur curable layer. Applicant notes the references do not provide any basis for encapsulating the sulfur curable layer of King with a peroxide curable layer of Drake. Further, such construction would obviate any use or function of the encapsulated sulfur curable layer. Therefore, such modification is nonsensical.

However, the claims recite the opposite structure to what the references are asserted to render obvious.

Claims 63-73

Claims 63-73 recite the "uncured peroxide curable rubber layer on the metal reinforcement" and then the "uncured sulfur curable rubber layer" on the uncured peroxide curable rubber layer. Thus, Claims 63-73 require the structure:

<i>Sulfur curable layer</i>
Peroxide curable layer
Metal reinforcement

As the asserted obvious combination is directly contrary to the structure recited in Claims 63-73, the cited references cannot sustain the asserted rejection.

Claims 75-79 and 82-85

Claims 75-79 and 82-85 recite in part, "(b) an uncured peroxide curable bonding veneer bonded to at least a portion of the metal reinforcement; and (c) an uncured sulfur curable rubber layer on at least a portion of the uncured peroxide curable bonding veneer."

Thus, Claims 75-79 and 82-85 require the structure:

Sulfur curable layer
Peroxide curable layer
Metal reinforcement

As this structure is directly contrary to the asserted obvious combination of King and Drake, these claims are also in condition for allowance.

Claims 87-91 and 94-97

Claims 87-91 and 94-97 recite in part, (b) an uncured peroxide curable bonding veneer bonded to at least a portion of the metal reinforcement; and (c) an uncured non-peroxide cross linkable elastomer layer on at least a portion of the uncured peroxide curable bonding veneer."

Thus, Claims 87-91 and 94-97 require the structure:

Non-peroxide cross linkable layer
Peroxide curable layer
Metal reinforcement

As this structure is directly contrary to the asserted obvious combination of King and Drake, these claims are also in condition for allowance.

However, even if the combination of King and Drake is re-constructed to assert the claimed structure is obvious, the proposed combination does not comply with the legal requirements.

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability

of making the specific combination that was made by the applicant. [citations omitted] *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. [citations omitted] *Id.* at 1317.

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. [citations omitted] *Ecolochem v. Southern California Edison Co.* 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Id.* at 1073 "The opinion then lists each step and states where in the cited prior art references the step can be found. This reference-by-reference, limitation-by-limitation analysis wholly fails to demonstrate how the prior art teaches or suggests the combination claimed in the '411 patent. *Ecolochem* at 1075.

The Federal Circuit has stated the "implicit generalized finding by a district court that when one of ordinary skill was faced with a problem [of the patent] in view of a prior art reference, that the combination claimed would have been obvious is insufficient." *Ecolochem* at 1075.

A rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed. *Ecolochem* at 1076.

In *In re Dembiczak*, we noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and

the then-accepted wisdom in the field. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). *Ecolochem* at 1072.

King is directed to a weatherstrip with an uncured foot for accommodating imperfections and variations in the retention flange to provide a weather resistant seal with the retention flange. [Abstract]

That is, King addresses the problem:

It will be appreciated from the foregoing that there is a significant need for a weatherstrip design that overcomes the problems of the prior art. One aspect of the present invention is to provide a weatherstrip design that can tolerate sheet metal variations including retention flange height, seal gaps, retention flange thickness, set-offs and the like. Another aspect of the present invention is to provide a weatherstrip design that once placed in commercial production is capable of adapting to many of the excessive build variations encountered on vehicles during commercial production. (Col. 1)

King solves this problem by using an uncured foot 26 to bond to the flange.

The weatherstrip includes a foot of pliable uncured elastomeric material and a seal member of cured elastomeric material formed integral with the uncured foot. (Col. 1)

The problem of King is accommodating variations in the flange 16, wherein King solves the problem by including the uncurable elastomeric material between the cosmetic lip 28 and the flange.

As Drake is directed to a flowable adhesive elastomeric composition, the application of Drake to King would locate the Drake adhesive in the place of the uncurable elastomeric material between the cosmetic lip 28 and the flange 16 of King.


The examiner has not identified any basis, in either King or Drake, for adding an extra layer of material (the peroxide curable layer of Drake) to King, thereby effectively doubling the material costs as well as substantially increasing the weight of the resulting weatherseal. Increased cost and weight are not considerations which would suggest the proposed modification.

The asserted purpose of "having improved adhesion" [Paper 5, page 4] is inapplicable as there is only one elastomeric layer of King. Alternatively, if the uncured (uncurable) material of the foot 26 of King is replaced with the peroxide curable layer of Drake, the recited structure of layers is not disclosed.

Therefore, applicant respectfully submits the asserted rejections under 35 USC §103 cannot be sustained.

Therefore, all the pending claims, Claims 63-97 are in condition for allowance and such action is earnestly solicited. If, however, the examiner feels any further issues remain, he is cordially invited to call the undersigned so that any such matters may be promptly resolved.

Respectfully submitted,



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